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EXAMINER

WASSUM, LUKE S

ART UNIT	PAPER NUMBER
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2177

DATE MAILED: 07/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/188,492

Applicant(s)

BAE, SEONGHO

Examiner

Luke S. Wassum

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 16 February 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. The Applicant's amendment, filed 5 May 2003, has been received, entered into the record, and considered.
2. As a result of the amendment, claims 6, 11 and 16 have been amended. Claims 1-20 remain pending in the application.

### *The Invention*

3. The claimed invention is a data processing environment that supports the generation of reports on a periodic basis, and the delivery of said reports electronically to a user over the Internet.

### *Oath/Declaration*

4. The declaration filed on 5 May 2003 under 37 CFR 1.131 is sufficient to overcome the **Saliba et al.** reference (U.S. Patent Application Publication 2002/0065722).

### *Drawings*

5. The examiner notes that a proposed drawing correction to Figures 3, 4, 6 and 10 was received on 16 February 2001, and was approved by the examiner after subsequent amendments to the specification in the Office action of 7 August 2001, paper number 10. However, formal corrected drawings have not been submitted.

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In response to this Office action, formal corrected drawings to Figures 3, 4, 6 and 10, incorporating those changes noted in the proposed drawing correction filed 16 February 2001 are required to avoid abandonment of this application.

*Specification*

6. The receipt of substitute specification pages 20, 25 and 34 are acknowledged. These substitute pages, however, have not been entered into the record.

7. Earlier in the prosecution of the application, there were extensive corrections made to the specification, to the extent that the submission of a substitute specification was required by the examiner, and was submitted by the applicant on 23 May, 2001, as part of Amendment B, paper number 6. This specification is the current specification of record.

8. The text of substitute pages 20 and 25, filed with the current amendment, do not correspond to either the originally files pages 20 and 25, nor to pages 20 and 25 of the substitute specification.

Furthermore, the currently filed substitute pages 20 and 25 reintroduce the deficiencies of the originally filed specification that were remedied with the substitute specification of 23 May 2001.

9. While the text of currently filed substitute specification page 34 does correspond to page 34 of the specification of record, this substitute page also reintroduces the deficiencies of the originally filed specification that were remedied with the substitute specification of 23 May 2001.

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10. For these reasons, the substitute specification pages 20, 25 and 34 filed 5 May 2003 have not been entered into the record.

11. The disclosure is objected to because of the following informalities:

There is a typographical error on page 34, line 12 "...output to repository 330ia path 316...".

Also, there are numerous references in the specification to "the above-referenced, commonly-assigned, co-pending U.S. Patent Application", e.g., page 20, line 3, and page 25, line 14. Given the large number of commonly-assigned, co-pending U.S. Patent Applications cited in the front of the specification, the Applicant is required to cite specific application numbers, or remove the references from the specification.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 112*

12. In view of the amendments to claims 6, 11 and 16, the pending claim rejections under U.S.C. § 112 are withdrawn.

#### *Claim Rejections - 35 USC § 102*

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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14. Claims 1-4, 6-14 and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by **Remington et al.** (U.S. Patent 6,070,150).

15. Regarding claim 1, **Remington et al.** teaches a data processing environment and apparatus as claimed, the improvement comprising:

- a) a software controlled server (see biller computing unit 112 in Figure 4) responsively coupled to said user terminal (see consumer 114 in Figure 4) via a publicly accessible digital communications network (see network 116 in Figure 4) and responsively coupled to said database management system (see col. 9, lines 7-58, and col. 10, lines 33-42, teaching the detailed information in the formatted bills, a teaching which renders the existence of a database management system inherent in the system) which receives said service request and forwards it to said database management system for honoring (see discussion of the "registration stage when the consumer initially signs up for the service", col. 15, lines 5-10, analogous to the claimed service request; see additionally the execution of a "change of address" request, col. 12, lines 8-17);
- b) an administration module which automatically determines a time to generate said report (see discussion of the initiation of the billing process, col. 15, line 67 through col. 16, line 1; see also col. 15, lines 35-43; see also disclosure of the prior art periodic generation of bills, col. 1, lines 28-32);
- c) a software object responsively coupled to said database management system and said administration module which executes a plurality of command script statements to generate said report in response to a signal from said administration module (see discussion of billing statement generation, col. 7, lines 50-54); and

d) a storage facility wherein said server spools said report in HTML format for future delivery to said user terminal (see discussion of the embodiment wherein the customer receives a notification to check a billing mailbox to retrieve electronic bills, col. 8, lines 17-22; see also discussion of the use of HTML in generating bills, col. 12, lines 24-60; see also discussion of sending the generated bills to an intermediary for future delivery to the customer, col. 16, lines 14-43, and particularly lines 35-43).

16. Regarding claim 6, **Remington et al.** teaches an apparatus as claimed, comprising:

- a) a user terminal which displays a report (see consumer 114 in Figure 4);
- b) a publicly accessible digital communications network coupled to said user terminal (see network 116 in Figure 4);
- c) a software controlled server responsively coupled to said user terminal via said publicly accessible digital communications network (see biller computing unit 112 in Figure 4);
- d) a database management system which automatically generates said report by executing a sequence of command script statements in response to a predetermined signal not initiated by said user terminal responsively coupled to said server (see col. 9, lines 7-58, and col. 10, lines 33-42, teaching the detailed information in the formatted bills, a teaching which renders the existence of a database management system inherent in the system; see also discussion of billing statement generation, col. 7, lines 50-54);
- e) an administration module within said server which spools said report for later electronic delivery to said user terminal at a future time (see discussion of the embodiment wherein the customer receives a notification to check a billing mailbox to retrieve electronic bills, col. 8, lines 17-22; see also discussion of sending the generated bills to

an intermediary for future delivery to the customer, col. 16, lines 14-43, and particularly lines 35-43).

17. Regarding claim 11, **Remington et al.** teaches a method of communicating between a user terminal and a database management system as claimed, comprising:

- a) automatically generating a report by said database management system through execution of a series of command script statements in response to a sensed signal at a first predetermined time determined by an administration module (see col. 9, lines 7-58, and col. 10, lines 33-42, teaching the detailed information in the formatted bills, a teaching which renders the existence of a database management system inherent in the system; see also discussion of billing statement generation, col. 7, lines 50-54; see also discussion of the initiation of the billing process, col. 15, line 67 through col. 16, line 1; see also col. 15, lines 35-43; see also disclosure of the prior art periodic generation of bills, col. 1, lines 28-32);
- b) converting said report into an HTML display page (see discussion of the use of HTML in generating bills, col. 12, lines 24-60);
- c) spooling said HTML display page within a repository (see discussion of the embodiment wherein the customer receives a notification to check a billing mailbox to retrieve electronic bills, col. 8, lines 17-22; see also discussion of sending the generated bills to an intermediary for future delivery to the customer, col. 16, lines 14-43, and particularly lines 35-43);
- d) making a service request from said user terminal to said database management system (see discussion of the "registration stage when the consumer initially signs up for the



service", col. 15, lines 5-10, analogous to the claimed service request; see additionally the execution of a "change of address" request, col. 12, lines 8-17); and

- e) transmitting said HTML display page from said database management system to said user terminal at a future time (see discussion of the embodiment wherein the customer receives a notification to check a billing mailbox to retrieve electronic bills, col. 8, lines 17-22; see also discussion of sending the generated bills to an intermediary for future delivery to the customer, col. 16, lines 14-43, and particularly lines 35-43).

18. Regarding claim 16, **Remington et al.** teaches an apparatus as claimed, comprising:

- a) means for permitting a user to interact with a digital database by making a service request and for displaying a report (see consumer 114 in Figure 4);
- b) means responsively coupled to said permitting means for providing said user with access to a publicly accessible digital communications network (see network port 170 in Figure 6; see also network 116 in Figure 4);
- c) means responsively coupled to said permitting means for generating a report at a first predetermined time by executing a sequence of command script statements (see col. 9, lines 7-58, and col. 10, lines 33-42, teaching the detailed information in the formatted bills, a teaching which renders the existence of a database management system inherent in the system; see also discussion of billing statement generation, col. 7, lines 50-54; see also discussion of the initiation of the billing process, col. 15, line 67 through col. 16, line 1; see also col. 15, lines 35-43; see also disclosure of the prior art periodic generation of bills, col. 1, lines 28-32); and

d) means responsively coupled to said generating means and said permitting means for spooling said report for delivery at a future time to said permitting means (see discussion of the embodiment wherein the customer receives a notification to check a billing mailbox to retrieve electronic bills, col. 8, lines 17-22; see also discussion of sending the generated bills to an intermediary for future delivery to the customer, col. 16, lines 14-43, and particularly lines 35-43).

19. Regarding claim 2, **Remington et al.** additionally teaches an improvement further comprising a plurality of user terminals which display said report and wherein said software controlled server electronically delivers said report to said plurality of terminals (see disclosure that prior art systems distributed bills to a plurality of customers, col. 1, line 64 through col. 2, line 44; see also disclosure that the bill is transmitted to a plurality of users, col. 16, lines 14-42, and particularly lines 36-38).

20. Regarding claim 3, **Remington et al.** additionally teaches an improvement wherein said publicly accessible digital communications network is the World Wide Web (see col. 7, lines 19-27).

21. Regarding claim 4, **Remington et al.** additionally teaches an improvement wherein said storage facility further comprises a repository wherein said repository includes space for storage of said report in final form (see disclosure that bills, analogous to the claimed report, are kept in a "billing mailbox", analogous to the claimed repository, col. 8, lines 17-22; see also disclosure that the billing information is stored at an intermediary, analogous to the claimed repository, col. 16, lines 14-42).

22. Regarding claim 7, **Remington et al.** additionally teaches an apparatus further comprising a plurality of user terminals which display said report (see disclosure that prior art systems distributed bills to a plurality of customers, col. 1, line 64 through col. 2, line 44; see also disclosure that the bill is transmitted to a plurality of users, col. 16, lines 14-42, and particularly lines 36-38).

23. Regarding claim 8, **Remington et al.** additionally teaches an apparatus further comprising a repository located within said server for storing said report in final form for later electronic delivery to said plurality of users (see disclosure that bills, analogous to the claimed report, are kept in a "billing mailbox", analogous to the claimed repository, col. 8, lines 17-22).

24. Regarding claim 9, **Remington et al.** additionally teaches an apparatus wherein said publicly accessible digital communications network is the World Wide Web (see col. 7, lines 19-27).

25. Regarding claim 10, **Remington et al.** additionally teaches an apparatus wherein said user terminal is an industry compatible personal computer having a web browser (see disclosure of an industry standard personal computer at col. 8, line 33 through col. 9, line 6; see disclosure of the use of a web browser at col. 12, lines 23-33).

26. Regarding claim 12, **Remington et al.** additionally teaches a method wherein said user terminal comprises an industry compatible personal computer (see disclosure of an industry standard personal computer at col. 8, line 33 through col. 9, line 6).

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27. Regarding claim 13, **Remington et al.** additionally teaches a method further comprising a plurality of user terminals (see disclosure that prior art systems distributed bills to a plurality of customers, col. 1, line 64 through col. 2, line 44; see also disclosure that the bill is transmitted to a plurality of users, col. 16, lines 14-42, and particularly lines 36-38).

28. Regarding claim 14, **Remington et al.** additionally teaches a method wherein said transmitting step further comprises transmitting over the World Wide Web (see col. 7, lines 19-27).

29. Regarding claim 17, **Remington et al.** additionally teaches an apparatus wherein said publicly accessible digital communication network further comprises the World Wide Web (see col. 7, lines 19-27).

30. Regarding claim 18, **Remington et al.** additionally teaches an apparatus wherein said generating means further comprises means for storing said report in final form (see disclosure that bills, analogous to the claimed report, are kept in a "billing mailbox", analogous to the claimed means for storing, col. 8, lines 17-22; see also disclosure that the billing information is stored at an intermediary, analogous to the claimed means for storing, col. 16, lines 14-42).

### *Claim Rejections - 35 USC § 103*

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

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skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. Claims 5, 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Remington et al.** (U.S. Patent 6,070,150) as applied to claims 1-4, 6-14 and 16-18 above, and further in view of **Admission** (Admitted Prior Art).

33. Regarding claims 5, 15 and 19, **Remington et al.** teaches a data processing environment, method and apparatus substantially as claimed.

**Remington et al.** does not explicitly teach a data processing environment, method and apparatus wherein said database management system is CLASSIC MAPPER.

**Admission**, however, teaches the CLASSIC MAPPER database management system (see applicant's specification [as amended], page 4, lines 7-13).

It would have been obvious to one of ordinary skill at the time of the invention to incorporate the CLASSIC MAPPER database management system, since it is admitted as prior art that CLASSIC MAPPER is one of the most successful database management systems (see page 4, lines 9-12).

Furthermore, demonstrated commercial success implies that the product has features that are advantageous over competing products. (else why would people buy it?) Additionally, the desire to make one's system compatible with others would additionally provide motivation for one to choose a database management product that has a wide commercial success, since this necessarily

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means that many other systems also employ the same database management product, and thus compatibility with other systems is enhanced

34. Regarding claim 20, **Remington et al.** additionally teaches an apparatus wherein said permitting means is an industry compatible personal computer (see disclosure of an industry standard personal computer at col. 8, line 33 through col. 9, line 6).

### *Response to Arguments*

35. Applicant's arguments filed 5 May 2003 have been fully considered but they are not persuasive.

36. Regarding the applicants' arguments that the examiner has failed to meet the requirements of MPEP § 2143 in showing obviousness, the examiner respectfully responds that the secondary reference, both in general and particularly in the specific portions cited in the rejection of record, supplies ample motivation to incorporate the MAPPER database management system, as well as providing reasons for expecting success in the combination.

### *Conclusion*

37. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Teper et al.** (U.S. Patent 5,815,665) teaches an Online Brokering Service which provides billing services over the Internet.

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**Dent et al.** (U.S. Patent 6,128,603) teaches a consumer-based bill management and payment system configured to receive, analyze, manage and pay electronic billing statements received from the biller over the Internet.

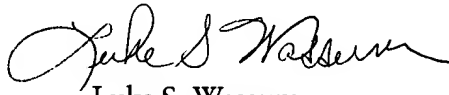
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 703-305-5706. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 703-305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 703-746-5658.

Customer Service for Tech Center 2100 can be reached during regular business hours at (703) 306-5631, or fax (703) 746-7240.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
Luke S. Wassum  
Art Unit 2177

lsw  
July 8, 2003